

## REMARKS

Claims 11, 12, 14, 15, 21, 22, 24, and 25 are pending.

Claims 11, 12, 14, 15, 21, 22, 24, and 25 stand rejected.

Claim 11 has been amended to recite in part “including the leaf node, for each leaf node in the primary hierarchy, ~~from the primary hierarchy~~ in the custom browse hierarchy ...” and “including the ancestor node, for each ancestor node in the primary hierarchy, ~~from the primary hierarchy~~ in the custom browse hierarchy ...”. Claim 11 has been amended for clarity to delete “from the primary hierarchy” because the phrase is redundant.

Claims 11 and 21 have been amended to clearly indicate “including the ancestor node ... in the custom browse hierarchy ...”.

Claim 21 has also been amended for clarity to address a minor, grammatical informality.

## **Claim Objections**

Claims 11, 21, and 24 are objected to because of various informalities. Applicants respectfully traverse the objection.

The Office Action indicates that the preambles of claims 11, 21, and 24 are objected to.

The preambles of claims 11 and 21 recite in relevant part:

... wherein the primary hierarchy comprises leaf nodes and one or more ancestor nodes of one or more of the leaf nodes, each leaf node defines a set of one or more items that meets constraints of the leaf node and each ancestor node, if any, of the leaf node, and the constraints of each leaf node and each ancestor node, if any, of the leaf node comprise one or more attribute names and one or more attribute values ... (emphasis added).

The Office Action indicates that the bolded text “the leaf node” should be amended to recite “the leaf nodes”. Applicants respectfully disagree. Applicants respectfully submit that the doubled-underlined “each leaf node” provides the singular antecedent of both instances of the double-underlined, bolded “the leaf node”. Likewise, Applicants respectfully submit that the single-underlined “each leaf node” provides the singular antecedent of the single-underlined, bolded “the leaf node”.

Applicants believe that the identification of claim 24 in the claim objection was an inadvertent error because claim 24 depends from claim 21 and does not include the objected to language identified in the Office Action.

Accordingly, Applicants respectfully submit that the language of claims 11 and 21 is proper and respectfully request withdrawal of the objections.

### **Claim Rejections - 35 U.S.C. § 112**

#### **I.**

Claims 11, 12, 21, and 22 stand rejected under 35 U.S.C. § 112, second paragraph, as being incomplete for omitting essential steps. Applicants respectfully traverse the rejection.

The Manual of Patent Examining Procedure §2172.01 (Unclaimed Essential Matter) states:

A claim which omits matter disclosed to be essential to the invention as described in the specification or in other statements of record may be rejected under 35 U.S.C. 112, first paragraph, as not enabling. *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). See also MPEP § 2164.08(c). Such essential matter may include missing elements, steps or necessary structural cooperative relationships of elements described by the applicant(s) as necessary to practice the invention.

In addition, a claim which fails to interrelate essential elements of the invention as defined by applicant(s) in the specification may be rejected under 35 U.S.C. 112, second paragraph, for failure to point out and distinctly claim the invention. See *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976); *In re Collier*, 397 F.2d 1003, 158 USPQ 266 (CCPA 1968). >But see *Ex parte Nolden*, 149 USPQ 378, 380 (Bd. Pat. App. 1965) ("[I]t is not essential to a patentable combination that there be interdependency between the elements of the claimed device or that all the elements operate concurrently toward the desired result"); *Ex parte Huber*, 148 USPQ 447, 448-49 (Bd. Pat. App. 1965) (A claim does not necessarily fail to comply with 35 U.S.C. 112, second paragraph where the various elements do not function simultaneously, are not directly functionally related, do not directly intercooperate, and/or serve independent purposes.).

Claim 11 recites in relevant part:

including the leaf node, for each leaf node in the primary hierarchy, in the custom browse hierarchy if the rule associated with the leaf node is included in the subset of rules and excluding the leaf node from the custom browse hierarchy if the rule associated with the leaf node is not included in the subset of rules;

The Office Action, para. 7, states that the following is an omitted step that should follow the immediately foregoing “including the leaf node” element of claim 11:

for each leaf node in the primary hierarchy, including the leaf node not from the primary hierarchy ... if the rule is not associated with the leaf node is not included in the subset of rules and the leaf node is not excluded from the custom browse hierarchy if the rule is not associated with the leaf node in the subset of rules;

Additionally, claim 11 also recites in relevant part:

including the ancestor node, for each ancestor node in the primary hierarchy, in the custom browse hierarchy if at least one leaf node of the ancestor node is included in the custom browse hierarchy and otherwise excluding the ancestor node from the custom browse hierarchy

The Office Action, para. 7, states that the following is also an omitted step that should follow the immediately foregoing “including the ancestor node” element of claim 11:

for each ancestor node in the primary hierarchy, including the ancestor node from the primary hierarchy if at least one leaf node of the ancestor node is not included in the custom browse hierarchy and otherwise including the ancestor node from the custom browse hierarchy;

It appears that the Examiner is indicating that the negative of the “including the leaf node” and the “including the ancestor node” elements of claim 11. (However, this is not completely clear. For example, the Examiner indicates that Applicants should include “for each leaf node in the primary hierarchy, including the leaf node not from the primary hierarchy.” It is unclear how to include “the leaf node not in the primary hierarchy” “for each leaf node in the primary hierarchy.”)

Nevertheless, Applicants respectfully submit that there is no “unclaimed essential matter” that must be present in claim 11. The MPEP § 2172.01 states that “A claim which omits matter disclosed to be essential to the invention as described in the specification or in other statements of record may be rejected” and “a claim which fails to interrelate essential elements of the invention as defined by applicant(s) in the specification may be rejected.” (emphasis added).

Applicants respectfully submit that the Examiner has failed to make a prima facie case that the specification or any other statements of record indicate that the alleged omitted steps have been disclosed or defined as “essential to the invention” or “essential elements of the

invention". The Office Action, para. 7, simply makes the allegation that "Claims 11, 12, 21, and 22 [are] incomplete for omitting essential steps, such omission amounting to a gap between the steps." However, the Office Action does not cite any portion of the specification or any other statements of record that indicate that the alleged omitted steps have been disclosed or defined as "essential to the invention" or "essential elements of the invention" as required by MPEP § 2172.01.

To the contrary, Applicants respectfully submit that the specification specifically states that, "The above embodiments illustrate but do not limit the invention." Present Application, p. 29, line 9. Accordingly, Applicants respectfully disagree that the steps identified by the Examiner on p. 6, para. 12 of the December 15, 2006 Office Action, are unclaimed essential matter.

Applicants respectfully submit that for purposes of this 35 U.S.C. § 112, 2<sup>nd</sup> paragraph rejection, the remarks related to claim 11 are representative of the arguments for also withdrawing the rejection of claims 12, 21, and 22.

Accordingly, Applicants respectfully request that the Examiner specifically identify in the specification or any other statements of record that the alleged omitted steps have been disclosed or defined as "essential to the invention" or "essential elements of the invention" or withdraw of the rejection.

## II.

Claims 11, 12, 14, 15, 21, 22, 24, and 25 stand rejected under 35 U.S.C. § 112, second paragraph because "represents a pared version of the primary hierarchy" is unclear and not understood whether Applicants' mean "represents a paired version of the primary hierarchy" because it is unclear what "represents a pared version of the primary hierarchy means." Office Action, para. 8. Applicants respectfully traverse the rejection.

In claims 11, 12, 14, 15, 21, 22, 24, and 25, the custom browse hierarchy represents a "pared" version of the primary hierarchy because the custom browse hierarchy is derived from the primary hierarchy and is a subset of the primary hierarchy. Thus, the custom browse hierarchy represents a "pared" version of the primary hierarchy.

For example, “Moreover, the browse hierarchy is pared down in scope from the most general primary hierarchy . . . .” Present Application, p. 12, lines 22-23. Note, the present invention is defined by the claims and not by specific embodiments described in the present application.

Accordingly, Applicants respectfully request withdrawal of the rejection.

### **WITHDRAWN CLAIMS**

If the non-withdrawn claims are allowed, Applicants respectfully request re-entry of at least the withdrawn claims that depend directly or indirectly depend upon allowed independent claims.

### **CONCLUSION**

In view of the amendments and remarks set forth herein, the application is believed to be in condition for allowance and a notice to that effect is solicited. Nonetheless, should any issues remain that might be subject to resolution through a telephonic interview, the examiner is requested to telephone the undersigned.

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Respectfully submitted,

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